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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,206	12/12/2003	James Kelly	C1120	1794
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RYAN KROMHOLZ & MANION, S.C. POST OFFICE BOX 26618 MILWAUKEE, WI 53226			QIN, JIANCHUN	
			ART UNIT	PAPER NUMBER
			2837	

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/735,206	Applicant(s) KELLY, JAMES	
	Examiner Jianchun Qin	Art Unit 2837	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-10, 19, 20, 31-34, 48 and 49 is/are allowed.
- 6) ☒ Claim(s) 1-7, 11-18, 21-30, 35-47 and 50-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/31/05 & 11/23/05 & 4/27/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders (U.S. Pat. No. 3728929) in view of Runyon (U.S. Pat. No. 6673992) and Garitano (U.S. Pub. No. 20030017311).

Regarding claim 1, Sanders teaches a mouthpiece for a brass wind musical instrument comprising a shank, and a cup integral with the shank, the shank and cup defining an axially extending aperture configured to conduct vibrating air (col. 1, lines 56-65; col. 2, lines 10-18 and lines 25-29).

Sanders does not mention: said mouthpiece is colored; the mouthpiece being made solely from a selected polymer material; and a colorant of a selected color that imparts the selected color to the polymer material.

Runyon teaches a mouthpiece for wind musical instrument, and said mouthpiece being made solely from a selected polymer material (col. 6, lines 59-62).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teaching of Runyon in the invention of Sanders in

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order to provide a mouthpiece for various wind musical instruments which is lightweight, less expensive, more user-friendly, and better for harmonic vibration (Runyon, col. 6, lines 59-62).

Garitano teaches a colorant of a selected color that imparts the selected color to the polymer material (page 7, 2nd col., line 5) for making musical items, including woodwind (page 9, col. 1, line 11).

It would have been obvious to one having ordinary skill in the art to modify the combination of Sanders and Runyon as taught by Garitano to color the polymer mouthpiece by include a colorant of a selected color that imparts the selected color to the polymer material for the purpose of making musical items.

3. Claims 2, 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders in view of Runyon and Garitano, as applied to claim 1 above, and further in view of Janssen et al. (U.S. Pat. No. 5805264).

Regarding claim 2, Sanders in view of Runyon and Garitano teach the mouthpiece that includes the subject matter discussed above except that the polymer material is polycarbonate.

Janssen et al. teach process for modifying the surface characteristics of a preformed polymer substrate, wherein the polymer material is polycarbonate (col. 4, lines 26-36).

It would have been obvious to one having ordinary skill in the art to incorporate the teaching of Janssen et al. into the combination of Sanders, Runyon and Garitano as

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one of the design choices for making a polymeric mouthpiece with polycarbonate (Janssen et al., col. 4, lines 26-36).

Regarding claim 3, It is obvious that Sanders in view of Runyon, Garitano and Janssen et al. disclose the claimed invention.

Regarding claim 7: It is obvious from the teaching of Sanders in view of Runyon, Garitano and Janssen et al. that a brass wind instrument is an essential pad for the mouthpiece to be inserted.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders in view of Runyon and Garitano further in view of Janssen et al., as applied to claims 1 and 2 above, and further in view of Wean (U.S. Pat. No. 4,658,697).

Regarding claim 4, The combination of Sanders, Runyon, Garitano and Janssen et al. discloses the claimed invention except that the colorant material cooperate to render the mouthpiece transparent.

Wean teaches a transparent mouthpiece for training a student (abstract).

It would have been obvious to one having ordinary skill in the art to modify the combination of Sanders, Runyon, Garitano and Janssen et al. as taught by Wean to include the colorant material cooperate to render the mouthpiece transparent for the purpose of training a student.

5. Claims 5, 12, 13, 15, 17-18, 23, 41-42, 46-47 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders in view of Runyon and Garitano as applied to claim 1 above, and further in view of Dolmetsch (U.S. Pat. No. 3,750,521).

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Regarding claims 5 and 41-42, Sanders in view of Runyon and Garitano disclose the claimed invention except that the mouthpiece is manufactured by an injection molding process.

Dolmetsch teaches a mouthpiece (21) made by injection molding (col. 2, lines 19-20) for mass production.

It would have been obvious to one having ordinary skill in the art to modify Sanders in view of Runyon and Garitano's mouthpiece as taught by Dolmetsch to include the mouthpiece being manufactured by an injection molding process for the purpose of mass production.

Regarding claims 12 and 15, see above.

Regarding claims claim 13, Sanders discloses the claimed invention.

Regarding claims 17, 18, 23 and 51, it is obvious that Sanders in view of Runyon, Garitano and Dolmetsch obviously disclose the method steps of manufacturing a mouthpiece as claimed.

Regarding claims 46-47, Sanders discloses the steps of a. and b. (a design that replicates the traditional cup, throat, back bore and performance of brass mouthpiece...), and Sanders in view of Runyon, Garitano and Dolmetsch obviously disclose the other method steps as claimed.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders in view of Runyon and Garitano as applied to claim 1 above, and further in view of Disera (U.S. Pat. No. 5,357,837).

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Regarding claim 6, Sanders in view of Runyon and Garitano disclose the claimed invention except that the mouthpiece is manufactured by machining a bar of polymer material.

Disera teaches a mouthpiece (20) being manufactured by machining (col. 3, lines 59-60). Further, it is known that machining an item such as mouthpiece is a known art.

It would have been obvious to one having ordinary skill in the art to modify Sanders in view of Runyon and Garitano's mouthpiece as taught by Disera to include the mouthpiece being manufactured by machining a bar of polymer material for the purpose of manufacturing the mouthpiece.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders in view of Runyon and Garitano as applied to claim 7 above, and further in view of the applicant's admission (page 1, lines 32-34).

Regarding claim 11, Sanders in view of Runyon and Garitano disclose the claimed invention except that the polycarbonate material and the selected colorant material cooperate to render the mouthpiece a color that is gold or silver color, so that the mouthpiece color blends in with the first color.

The applicant admits that whatever the material, their colors were generally the same as the color of the instrument, i.e. gold or silver. The mouthpiece thus tended to blend into the instrument.

It would have been obvious to one having ordinary skill in the art to modify Sanders in view of Runyon and Garitano's combination as taught by the applicant's admission to include the polycarbonate material and the selected colorant material

cooperate to render the mouthpiece a color that is gold or silver color, so that the mouthpiece color blends in with the first color.

8. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders in view of Runyon, Garitano and Dolmetsch as applied to claim 41 above, and further in view of Janssen et al. (U.S. Pat. No. 5805264).

Regarding claim 44, Sanders in view of Runyon, Garitano and Dolmetsch teach the mouthpiece that includes the subject matter discussed above except that the selected polymer material is polycarbonate.

Janssen et al. teach process for modifying the surface characteristics of a preformed polymer substrate, wherein the polymer material is polycarbonate (col. 4, lines 26-36).

It would have been obvious to one having ordinary skill in the art to incorporate the teaching of Janssen et al. into the combination of Sanders, Runyon, Garitano and Dolmetsch as one of the design choices for making a polymeric mouthpiece with polycarbonate (col. 4, lines 26-36).

9. Claims 14, 43 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders in view of Runyon, Garitano and Dolmetsch as applied to claims 12, 41 and 46 respectively above, and further in view of Wean.

Regarding claims 14, 43, and 50, see above.

10. Claims 16 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders in view of Runyon, Garitano and Dolmetsch as applied to claims 12 and 41 respectively above, and further in view of Getzen (U.S. Pat. No. 4,754,682).

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Regarding claims 16 and 45, the combination of Sanders, Runyon, Garitano and Dolmetsch discloses the claimed invention except that the mouthpiece is further manufactured by a secondary machining process subsequent to removing the mouthpiece from the molds.

Getzen teaches a mouthpiece is further manufactured by a secondary machining process subsequent to removing the mouthpiece from the molds for providing a very accurate bore (col. 2, lines 20-24, and col. 4, lines 42-45).

It would have been obvious to one having ordinary skill in the art to modify Sanders in view of Runyon and Garitano further in view of Dolmetsch's mouthpiece as taught by Getzen to include that the mouthpiece is further manufactured by a secondary machining process subsequent to removing the mouthpiece from the molds for the purpose of providing a very accurate bore.

11. Claims 21 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders in view of Runyon, Garitano and Dolmetsch as applied to claim 17 above, and further in view of Getzen.

Regarding claims 21, 24 and 25, see above.

12. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders in view of Runyon, Garitano and Dolmetsch as applied to claim 17 above, and further in view of Wean.

Regarding claim 22, see above.

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13. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders in view of Runyon, Garitano and Dolmetsch as applied to claim 17 above, and further in view of the applicant's admission.

Regarding claim 26 and 27, see above.

14. Claims 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders in view of Runyon, Garitano, Dolmetsch and Getzen.

Regarding claim 28, see above.

Regarding claim 29, Sanders in view of Runyon and Garitano disclose the claimed invention.

15. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders in view of Runyon, Garitano, Dolmetsch and Getzen as applied to claim 28 above, and further in view of Wean.

Regarding claim 30, see above.

16. Claims 35-36, 38, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders in view of Runyon, Garitano, Dolmetsch and Getzen.

Regarding claims 35 and 36, it is obvious that Sanders in view of Runyon, Garitano, Dolmetsch and Getzen disclose the method steps as claimed.

Regarding claim 38, see above.

Regarding claim 39, Sanders in view of Runyon and Garitano disclose the claimed invention.

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17. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders in view of Runyon, Garitano and Dolmetsch as applied to claim 35 above, and further in view of Disera.

Regarding claim 37, see above.

18. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders in view of Runyon, Garitano, Dolmetsch and Getzen as applied to claim 36 above, and further in view of Wean.

Regarding claim 40, see above.

19. Claims 52 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders in view of Runyon, Garitano and Dolmetsch as applied to claim 46 above, and further in view of the applicant's admission.

Regarding claims 52 and 53, see above.

20. Claims 54-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders in view of Runyon, Garitano and Disera.

Regarding claim 54, see above.

Regarding claims 55, see above.

21. Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders in view of Runyon, Garitano and Disera as applied to claim 54 above, and further in view of Wean.

Regarding claim 56, see above.

22. Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders in view of Runyon, Garitano and Disera as applied to claim 54 above, and further in view of Janssen et al.

Regarding claim 57, see above.

23. Claim 58-59, and 61-62 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders in view of Runyon and Disera.

Regarding claim 58, Sanders in view of Runyon disclose the claimed invention except that the step of providing a bar of a selected polymer material and machining the bar into a brass instrument mouthpiece.

Disera teaches a mouthpiece (20) being manufactured by machining (col. 3, lines 59-60). Further, it is known that machining an item such as mouthpiece is a known art.

It would have been obvious to one having ordinary skill in the art to modify Sanders in view of Runyon's method of manufacturing a mouthpiece as taught by Disera to include the mouthpiece being manufactured by machining a bar of polymer material for the purpose of manufacturing the mouthpiece.

Regarding claims 59 and 61, Sanders in view of Runyon discloses the claimed invention.

Regarding claim 62, see above.

24. Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders in view of Runyon and Disera as applied to claim 58 above, and further in view of Wean.

Regarding claim 60, see above.

Allowable Subject Matter

25. Claims 8-10, 19-20, 31-34 and 48-49 are allowed.

Reasons for Allowance

26. The claims are allowable over the prior art for at least the reason that the prior art fails to reasonably teach or suggest in claims 8, 19 and 48 that the polycarbonate material and the selected colorant cooperate to render the mouthpiece a color that is neither brass, gold, nor silver color, and in claim 31 that a mouthpiece bounded by a first outer periphery and a first aperture, the mouthpiece being fabricated by molding a mixture of polymer material and selected colorant material into a blank having a second outer periphery and a second aperture, and by performing a primary machining operation on the blank second outer periphery and second aperture to produce the first outer periphery and the first aperture as set forth in the claimed combination.

In regard to dependent claims 9, 10, 20, 32-34 and 49, they are allowed once the independent claim they depend on is allowed, even though they may contain allowable subject matter themselves.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

27. Applicant's arguments received 10/31/05 with respect to claims 1-62 have been considered but are moot in view of the new ground(s) of rejection.


Claims 1-7, 11-18, 21-30, 35-47 and 50-62 are rejected as new prior art references (U.S. Pat. No. 3728929 to Sanders and U.S. Pat. No. 6673992 to Runyon) have been found to teach, together with other cited references, the claimed invention recited in the claims listed above. Detailed responses are given in sections 2-24 as set forth above in this Office Action.

Contact Information

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jianchun Qin whose telephone number is (571) 272-5981. The examiner can normally be reached on 8:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Martin can be reached on (571) 272-2107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should


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JQ 
December 21, 2005